

APPLICANT: TRADEMARK OFFICE

Michael E. Tompkins, and §
Michael J. Green §
§
S SERIAL NO.: 08/385,062 §
§
FILED: February 7, 1995 §
§
FOR: SPA CONTROL SYSTEM §

GROUP ART UNIT: 2414

EXAMINER:
E. RAMIREZ

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Date: March 28, 1996
Atty File No.: 1461-00205

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The Applicants wish to bring the following information and the information identified on Form PTO-1449 to the attention of the U.S. Patent and Trademark Office. Defendants in *Siege Industries, Inc. v. Clark Manufacturing, Inc. et al.*, Civil Action No. H-94-3180 in the United States District Court for the Southern District of Texas, Houston Division, have alleged that a "700 Series" spa control developed by Balboa, Inc. ("Balboa") is prior art to U.S. Patent 5,361,215, the patent in suit in the above styled litigation. The '215 patent issued from an application which is a continuation-in-part of the present application. The expert witness for Defendant in the above-identified litigation has stated that the control system recited in claims 1, 2 and 37 of the '215 patent was invented by Mr. Pinkul of Balboa Instruments, Inc. before the date of invention of the present patent application, and was publicly disclosed to Clark Manufacturing more than one year prior to the priority date of the present application. See Exhibit "A". Further, Defendant alleges that the control system of claims 1, 2, 4, and 37 of the '215 patent would have been obvious to one of ordinary skill in the art at the time the alleged invention was made. See Exhibit "A".

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage at First Class U.S. Mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington, D.C. 20231

3-28-96

(Date)

M. D. P. B. T. Lee
(Printed name of person mailing paper)

D. C. C. Lee
(Signature of person mailing paper)

345

Balboa ultimately manufactured the Balboa 700 Series spa control for Clark Manufacturing, Inc. d/b/a Sundance Spas, the Defendant in the above-identified litigation. The Balboa 700 Series included a Model 701 and 724. These are described in a Sundance brochure having a 1988 copyright date and a revision date of June 1990, Exhibit "B". Tony Sadati, an employee of Sundance, testified that the development of the Balboa 700 Series began "probably August 1985". *See* Deposition of Tony Sadati, at page 144, line 25, (Exhibit "C"). Sundance also has produced documents 12167-8 and 12169. *See* Exhibit "D". Document 12167-8, entitled "Minutes of Meeting with Balboa Instruments - Dave Kline", is dated July 30, 1986 and "Confidential" is handwritten across the top of the first page. Tony Sadati also testified that at sometime in 1987, 50 prototypes of the Balboa 700 Series were built and given to dealers for their use. The earliest documented delivery of a Balboa 700 Series spa control by Balboa to Sundance, however, is March 30, 1988. *See* Exhibit "E". Balboa compared its 700 Series spa control to Applicant's spa control design on April 7, 1988. *See* Exhibit "F". Attached as Exhibit "G" is a 700 Schematic of the Balboa 700 Series dated October 19, 1988, with revisions dated December 8, 1988. The earliest documented sale of the Balboa 700 Series with prices is set forth in documents 12170-75 dated March 8, 1989. *See* Exhibit "H". The parent application of the present application was filed May 27, 1987.

In an effort to determine the facts relating to the research, design, development, production, and sale of the Balboa 700 Series spa control, Applicant subpoenaed the records of Balboa pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure (Exhibit "I") asking that Balboa designate one or more persons who can testify on its behalf concerning the research, design, development, production and sale of the Balboa 700 Series spa control. Balboa required that a Protective Order (Exhibit "J") be executed by all parties to, among other things, maintain the confidentiality of the deposition testimony and documents to be purchased by Balboa pursuant to the subpoena. The deposition of Allan Pinkul and Cindy Otto were taken January 17, 1996. The deposition exhibits and transcripts were designated

"Confidential" by Balboa.

Among the exhibits marked during the deposition of Mr. Pinkul and Ms. Otto were Exhibit 140 the subpoena (Exhibit "I"); Exhibit 141, twelve pages of handwritten notes and schematics of Mr. Pinkul with various dates ranging from June 15, 1983 to May 29, 1986; Exhibit 142, a memo dated March 21, 1989 with specifications for the 724 System for 1989; Exhibit 145, Spa Control Circuit 700 Series schematic dated July 22, 1985 and revised March 6, 1986; Exhibit 146, a 700 Series Safety Circuit schematic dated August 6, 1985; Exhibit 147, a Microprocessor Board schematic dated March 19, 1986; Exhibit 148, a 700 Series Circuit Schematic dated April 8, 1986; Exhibit 152, three prints of the 700 Series Panel dated June 10, 1986; Exhibit 153, an FCC report on the Balboa Model 700 signed August 25, 1987; Exhibit 154, a System Wiring Diagram dated September 1989; Exhibit 160, an undated print-out of a software program on the 700 Series Control System; Exhibit 161, two letters dated in December 1989 regarding high limit sensor; and Exhibit 164, a Sales and Purchasing Agreement dated July 1, 1986 between Clark Manufacturing and Balboa Instruments regarding spa equipment control systems.

On February 7, 1996, attorneys for Applicants requested Balboa to allow Applicants to submit the exhibits and deposition transcripts of the Pinkul and Otto depositions to the U.S. Patent and Trademark Office to allow the Examiner to first determine whether the Balboa 700 Series is prior art and if so, to compare the teachings of the Balboa 700 Series to the claims pending in the above-identified patent application. Subsequently, upon the request of Balboa, Applicant's attorneys specifically designated those portions of the transcripts and exhibits which it wished to submit to the U.S. Patent and Trademark Office. See Exhibit "K". Again, Balboa refused to release the depositions of Pinkul and Otto or the exhibits relating to the Balboa 700 Series to allow Applicants to submit all evidence relating to the Balboa 700 Series to the U.S. Patent and Trademark Office for its review and consideration in the prosecution of the above-identified patent application. See Exhibit "K".

Attached as Exhibit "L" is the expert witness report of Applicants. See in particular Page 6.

Applicants desire to fulfill their duty of candor and good faith pursuant to 37 C.F.R. § 1.56. Section 724.02 of the Manual of Patent Examining Procedure suggests a method of submitting confidential information of the Applicant that is subject to a protective order. However, the confidential information at issue is the information of a third party who is not a party to the litigation. Thus, if the submitted confidential information is found by the Examiner to be "material to the examination" under 37 C.F.R. 1.56(a), the confidential information will become a part of the file history and will become available to the public on the issuance of the patent. Such a publication could be construed as a violation of the Protective Order by the third party. Applicants request that the Examiner review the information submitted in this Supplemental Information Disclosure Statement and instruct Applicants as to whether the Examiner, from the description of the materials set forth in the Supplemental Information Disclosure Statement, believes that the confidential information under the Protective Order should be submitted pursuant to § 724.02. If the Examiner desires additional information, Applicant will then formally move the Court for relief under the terms of the Protective Order based upon the Examiner's request.

In accordance with MPEP §§ 609 and 707.05(b), it is requested that each document attached be given thorough consideration and that it be cited of record in the prosecution history of the present application by initialing on Form PTO 1449, so that it will appear on the face of the patent issuing on the present application, even if the Examiner does not consider it sufficiently pertinent to use in a rejection, or otherwise does not consider it to be prior art for any reason, or even if the Examiner does not believe that the guidelines for citation have been fully complied with.

The present Information Disclosure Statement is being submitted in compliance with 37 C.F.R. 1.56 as an Examiner might consider any cited document important in deciding whether to allow the application to issue as a patent. The submission of this Information Disclosure Statement and Form PTO 1449 is not an admission that the art cited is available as a reference under 35 U.S.C. § 101 *et seq.* or that it is relevant or more pertinent with respect to the present invention, nor is it a representation that

no better art exists. Applicant reserves the right to swear behind or otherwise disprove the alleged "prior" nature of any art cited should the facts support and the situation warrant such an action. Applicant respectfully requests that the Examiner review independently the original text of the cited material in detail, and independently evaluate each item carefully in the consideration of the pending claims.

No representation is intended that the cited documents represent the results of a complete search, and it is anticipated that the Examiner in the normal course of examination, will make an independent search and will determine the best prior art consistent with 37 C.F.R. 1.104(a) and 1.106(b), and in the course of such search will review for relevance every document cited on the attached form even if not initialed.

Please charge any fee required to Deposit Account No. 03-2769 of Conley, Rose & Tayon, P.C.
A duplicate copy of this transmittal is attached.

Respectfully submitted,



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238-8000

ATTORNEY FOR APPLICANT

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

SIEGE INDUSTRIES, INC.,

§

§

v.

§

§

CLARK MANUFACTURING, INC.,
d/b/a SUNDANCE SPAS,
ROLAND CLARK, and
W. JAMES CLARK

§

§

CIVIL ACTION NO.: H-94-3180

**DEFENDANTS' NOTICE OF PATENT INVALIDITY
PURSUANT TO 35 U.S.C. § 282**

TO: SIEGE INDUSTRIES, INC., by and through its attorneys of record: Mr. Steven D. Susman and Mr. Eric J. Mayer, Susman & Godfrey L.L.P., Suite 5100, 1000 Louisiana, Houston, Texas 77002

Pursuant to 35 U.S.C. § 282, defendants Clark Manufacturing, Inc., d/b/a Sundance Spas, Roland Clark, and W. James Clark ("Clark") give notice of the following patents (Exhibit A), publications (Exhibit B), and persons (Exhibit C) which may be relied upon in establishing the invalidity of United States Patent No. 5,361,215. Defendants reserve the right to present additional prior art at trial. Further, Defendants reserve the right to decline to offer any of the listed patents, publications, or persons at trial.

Respectfully submitted,

WEIL, GOTSHAL & MANGES LLP

By:


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**DEFENDANTS' NOTICE OF PATENT INVALIDITY
PURSUANT TO 35 U.S.C. § 282**

Page 1

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ATTORNEYS FOR DEFENDANTS CLARK
MANUFACTURING, INC., D/B/A SUNDANCE
SPAS, ROLAND CLARK, AND W. JAMES
CLARK

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing instrument was served by Hand Delivery and certified mail, return receipt requested, on the counsel listed below, on August 5, 1996:

Mr. Eric J. Mayer
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Mr. Jeffrey Tayon
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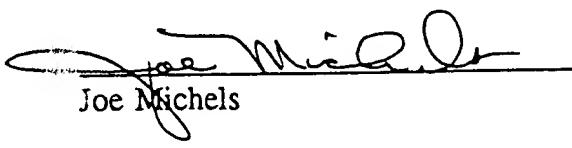

Joe Michels

EXHIBIT A
(PATENTS)

Patent No.	Patent	Inventor	Date of Issue	Country
Re. 33,119	Selective Temperature Control System	Baker	11/28/89	US
0,009,249	Indicating and Operating Mechanism for Electrical Appliances	Kupferer, et al.	04/02/80	EP
2,562,687		Kessler, et al.	10/11/85	FR
3,400,374	Computerized Control System	Schumann	09/03/68	US
3,459,925	High Speed Temperature Monitor	Goosey	08/05/69	US
4,001,557	Stored Program Digital Process Controller	Stephenson	01/04/77	US
4,071,745	Programmable Time Varying Control System and Method	Hall	01/31/78	US
4,114,442	Temperature Monitoring System	Pratt	09/19/78	US
4,116,228	Respiration Data Acquisition, Conversion and Display System	Hudspeth	09/26/78	US
4,121,574	Method and Apparatus for Measuring and Recording Vital Signs of a Patient	Lester	10/24/78	US
4,161,880	Linearized Digital Thermometer	Proskey	07/24/79	US
4,198,676	General Purpose Electronic Thermometer Having Selective Data Recovery, Data Conversion, and Data Derivation Capabilities	Varnum	04/15/80	US
4,204,204	On/Off Switch Arrangements for a Touch Control Bar Graph Device	Pitstick	05/20/80	US
4,215,398	Dual Microprocessor Intelligent Programmable Process Control System with Communication Link	Burkett, et al	07/29/80	US
4,237,562	Massage Installation	DuPont	12/09/80	US

Patent No.	Patent	Inventor	Date of Issue	Country
4,265,298	Microcomputer Control for Supplemental Heating with Night Set-Back	Sumner, Jr.	05/05/81	US
4,266,599	Method and Apparatus for Controlling Comfort Conditions Including Setback	Saunders	05/12/81	US
4,269,261	Microcomputer Control for Supplemental Heating in a Heat Pump	Kountz	05/26/81	US
4,270,693	Electronic Thermostat with Heat Anticipation and Control Method Incorporating Same	Hayes	06/02/81	US
4,274,145	Digital Thermostat	Hendricks	06/16/81	US
4,276,603	Diffusion Furnace Microcontroller	Beck	06/30/81	US
4,276,925	Electronic Temperature Control System	Palmieri	07/07/81	US
4,284,126	Environmental Control System for a Multiple Room Structure	Dawson	08/18/81	US
4,293,028	Arrangement for Controlling Room Temperature	Knoll	10/06/81	US
4,298,946	Electronically Controlled Programmable Digital Thermostat	Hartsell	11/03/81	US
4,300,199	Thermostat	Yoknis	11/10/81	US
4,307,576	Air Conditioning System Having a Plurality of Indoor Units	Takano	12/29/81	US
4,308,991	Programmable Electronic Thermostat	Peinetti	01/05/82	US
4,314,665	Electronic Thermostat	Levine	02/09/82	US
4,316,256	Thermostat with Automatic Heat/Air Conditioning Changeover	Hendricks	02/16/82	US
4,319,711	Wall Thermostat and the Like	Barker	03/16/82	US
4,322,297	Controller and Control Method for a Pool System	Bajka	03/30/82	US

Patent No.	Patent	Inventor	Date of Issue	Country
4,368,549	Swimming Pool Heater Temperature Control System	Ramey	01/18/83	US
4,381,031	Spa-Domestic Hot Water Heat Exchanger	Whitaker, et al.	04/26/83	US
4,382,544	Energy Management System with Programmable Thermostat	Stewart	05/10/83	US
4,385,724	Apparatus for Controlling the Water Temperature of a Spa	Ramseur, et al.	05/31/83	US
4,386,649	Programmable Thermostatic Control Device	Hines	06/07/83	US
4,398,789	Opto-Electronically Controlled Bathing Systems	Pryor	08/16/83	US
4,403,296	Measuring and Determination Device for Calculating an Output Determination Based on a Mathematical Relationship Between Multiple Different Input Responsive Transducers	Proskey	09/06/83	US
4,404,697	Remote Control System for Spas	Hatcher	09/20/83	US
4,406,550	Temperature Monitoring and Utilization System	Gray	09/27/83	US
4,409,662	Programmable Digital Temperature Controller	Rao	10/11/83	US
4,409,694	Electronic Control Device for Liquids	Barrett, Sr., et al.	10/18/83	US
4,410,791	Electric Instant Water Heater	Eastep	10/18/83	US
4,421,270	Electronic Temperature Control	Raleigh, et al.	12/20/83	US
4,428,528	Environmental Thermostat Assembly	Renault	01/31/84	US
4,432,210	Air Conditioning Control Method	Saito	02/21/84	US
4,446,913	Auto Changeover Thermostat with Means for Handling Temperature Entry Errors	Krocker	05/08/84	US

Patent No.	Patent	Inventor	Date of Issue	Country
4,480,312	Temperature Sensor/Controller System	Wingate	10/30/84	US
4,504,010	Temperature Control Device	Sukimoto	03/12/85	US
4,527,246	Hot Water Heating System Control Device	Masson	07/02/85	US
4,563,780	Automated Bathroom	Pollack	01/14/86	US
4,564,962	Energy Efficient Thermosyphoning Spa Heater System	Castleberry, et al.	01/21/86	US
4,574,871	Heat Pump Monitor Apparatus for Fault Detection in a Heat Pump System	Parkinson	03/11/86	US
4,607,787	Electronic Control and Method for Increasing Efficiency of Heating	Rogers, III	08/26/86	US
4,621,613	Pool and Spa Heating and Cooling	Krumhansl	11/11/86	US
4,642,785	Cordless Electronic Thermometer	Packard	02/10/87	US
4,644,478	Monitoring and Alarm System for Custom Applications	Stephens	02/17/87	US
4,669,049	Temperature Measuring Instrument and Adapter for Same	Kosednar	05/26/87	US
4,676,914	Microprocessor Based Pump Controller for Backwashable Filter	Mills	06/30/87	US
4,682,728	Method and Apparatus for Controlling the Temperature and Flow Rate of a Fluid	Oudenhoven, et al.	07/28/87	US
4,693,415	Method and Circuitry for Control of a Sanitary Mixer for Cold and Hot Water	Sturm	09/15/87	US
4,696,428	Electronic Fluid Temperature Flow Control System	Shakalis	09/29/87	US
4,706,88	Adaptive Optimum Start	Barnard	11/17/87	US
4,711,392	Mixing Value Apparatus, for Mixing Hot and Cold Water Supplied from Hot and Cold Water Lines	Kidouchi, et al.	12/08/87	US

Patent No.	Patent	Inventor	Date of Issue	Country
4,713,525	Microcomputer Controlled Instant Electric Water Heating and Delivery System	Eastep	12/15/87	US
4,725,001	Electronic Thermostat Employing Adaptive Cycling	Carney	02/16/88	US
4,757,943	Method and Apparatus for Controlling the Temperature of a Liquid	Sperling, et al.	07/19/88	US
4,768,705	Cold/Hot Water Discharging Apparatus	Tsutsui, et al.	09/06/88	US
4,773,008	Environment Control of an Aquarium	Schroeder	09/20/88	US
4,780,917	Spa Construction with Integrated Spa Side and Inside Control System	Hancock	11/01/88	US
4,797,958	Bathtub with Improved Hydromassage System	Guzzini	01/17/89	US
6,014,677	Unknown	Miyauchi	01/25/83 01/25/85	JP

EXHIBIT B
(PUBLICATIONS)

Title of Publication	Date of Publication	Page Number of Publication
Spa Troller Newsletter #1	12/10/81	N/A
Spa Troller Newsletter #3	12/18/81	1
Spa Troller Newsletter #4	03/00/82	1-2
Spa Troller Newsletter #5	06/01/82	1-2
Sundance Spas Sentry 700 Series Installation and Owners Manual	00/00/88	N/A
Spa Troller Newsletter #5	09/00/82	1
Pool & Spa News, Advertisement, Catalina Controls	11/03/86	249
Hydrotouch II, Digital Command Center by Baker Hydro, Inc., a division of T.O.C., Inc.	00/00/88	N/A
"Spa-Troller, The Computerized System" by the Spa-Trol Company	05/03/82	N/A
Pool & Spa News, Advertisement, Sp. Tec, a subsidiary of Siege Industries	04/06/87	60
Sundance 700 Manual	06/00/90	N/A
Sundance 800 Manual	06/00/94	N/A
Catalina Controls Corporation: Features of the Microprocessor-Based Distribution Products Family	09/29/86	N/A
Spa-Trol Owners Manual and Theory of Operation		N/A
Underwriters' Laboratories Standard 1563, Rev 3	011/00/92	N/A
Underwriters' Laboratories Standard 1563, Rev 2	05/00/82	N/A
Underwriters' Laboratories Standard 991		

Spa & Sauna Magazine	05/00/87	N/A
Sta-Rite System 110 Owner's Manual	04/00/88	11 & 23
Distributors International Catalogue		Ex. 130: 43
Spa-Temp St-1100 Installation and Operation Manual	00/00/82	7, 11
CalSpas Newsletter	03/00/87	3
Spa-Trol Brochure	01/15/82	1-7
Spa-Temp St-800 Freeze Protector Installation and Operation Manual	00/00/82	N/A
Catalina Controls RC-4P Installation Guide	00/00/86	5
Spa-Tec Controller Description and Theory of Operation	02/06/87	N/A
Aquatrol Description and Theory of Operation	02/01/87	N/A
Spa-Tec IMP Brochure	1987	N/A
Spa-Tec Brochures	05/01/87	N/A
IMP Interfaced Modular Programmer User's Guide	1987	N/A
Houston Chronicle Newspaper IMP ad,	01/23/88	N/A
Block diagram of 800/600 Control System	01/25/88	N/A
Balboa 700 Schematic Drawing	1986	N/A
Spa Control - Electronic Thermostat drawings	1983-86	N/A
Balboa Blueprint Spa Control Circuit 1983	1983	N/A
Balboa Control Circuit Block Diagram	06/13/84	N/A
Balboa Spa Control Circuit - 700 Series	03/06/86	N/A
Balboa 700 Series Safety Circuit	08/06/85	N/A
Engineering Drawing of Microprocessor Board	03/19/86	N/A
700 Series Circuit Schematic	04/08/86	N/A

Balboa Circuit Schematic	04/28/83	N/A
National Semiconductor MA 1026 Digital LED Alarm Clock/Termometer Module Description with drawings	02/00/80	N/A
Balboa 700 Series Drawings	1986	N/A
Balboa Instruments Model 700, FCC Report	08/25/87	N/A
Spa-Troller Catalog	05/00/87	N/A
Hydrotouch II 1981 Catalog	1981	N/A
S 5 Spa-Package with Hydrotouch Catalog	11/19/79	N/A
Eaton Corporation Spa Monitor II - Functional Description and drawing	05/24/83	N/A
Balboa Computer Program	1986	N/A
Letter to Mike Tompkins, President of Secoa from Chip Siegel re: Spa-Tec IMP control	12/03/87	N/A
Nine (9) Letters from Jim Ferguson of Siege Ind. to potential purchasers of Spa-Tec IMP	06/19/87	N/A
SPA Tec IMP OEM Pricing Program Effective 08/01/87-12/31/87	Not Later Than 08/01/87	N/A
Correspondence to <i>Spa & Sauna</i> from James Ferguson re: exhibitor product preview - NSPI 31st Annual Convention/Expo	09/03/87	N/A
Letter to David Blevins from James Ferguson re: breakdown of prices	02/25/87	N/A
Letter to Haugh's Dist. from James Ferguson re: proposal	03/22/87	N/A
Letter to Plas-Tech Industries from James Ferguson re: proposal	03/18/87	N/A
Spa Monitor II - Functional Description	01/13/83	N/A
Sales Call Report -- Solid State Control	09/26/83	N/A
Sales Call Report -- Solid State Control	07/20/83	N/A
Sales Call Report -- Solid State Control	08/16/83	N/A